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Remarks

Applicants hereby add new claims 44-49. Accordingly, claims 1-15, 22-23, and 26-27, 29-49 are pending in the present application.

Claims 11-15, 26, 29-31, 33-34, 37, 39 and 42 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 2002/0018124 A1 to Mottur et al. in view of U.S. Patent No. 6,172,672 Ramasubramanian et al. Claims 1-10, 22-23, 27, 35-36, 38, 40-41 and 43 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mottur in view of Ramasubramanian and in further view of U.S. Patent Publication No. 2002/0024602 to Juen.

Applicants respectfully traverse the rejections and request allowance of all pending claims.

In response to the withdrawal of allowable subject matter by the Office, Applicants have amended claims 1 and 11 to return the claims to their respective statuses as pending before the previous response of Applicants filed August 4, 2005. Applicants had amended claims 1 and 11 in the previous response merely to further the prosecution of the present application and based upon the representations by the Office that claim 1 was allowable. For at least the reasons set forth herein, it is and has been Applicants' position that claims 1 and 11 pending before the previous Office Action are and were allowable over the prior art of record. Applicants respectfully request withdrawal of the rejections of the claims at least for the reasons presented herein.

Referring to the 103 rejection of claim 1, Applicants respectfully submit there is no motivation to combine the teachings of Ramsuabramanian with Mottur for at least the reasons presented in the responses filed by Applicants on February 10, 2005 and August 4, 2005. Applicants respectfully submit the Office has failed to establish a proper prima facie obviousness rejection for at least this reason and Applicants request withdrawal of the obviousness rejection of claim 1 in the next Action.

The claims which depend from claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to dependent claim 27, it is stated on page 16 of the Action that Mottur teaches that video is not stored before it is transmitted to the user and

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would be stored for a first time after the image is generated and transmitted to the user. However, the transmission of the video fails to disclose or suggest limitations with respect to the claimed high resolution photograph of claim 27 *let alone the claimed storing the high resolution photograph for the first time after the generating and transmitting*. Limitations of claim 27 are not disclosed nor suggested by the prior art even if the references are combined and the Office has failed to establish a prima facie 103 rejection for at least this reason.

Referring to dependent claim 35, the method recites *the high resolution photograph having a resolution greater than a resolution of the video*. The Office on page 16 of the Action relies upon the teachings of Ramsubramanian regarding high quality snapshots in support of the rejection. However, Mottur is concerned with avoiding choppy video as set forth in paragraph 0005 and there is no evidence of record that Mottur is concerned with photographs let alone photographs having a resolution greater than a resolution of video. The modification of Mottur proposed by the Office is contrary to the teachings of Mottur inasmuch as bandwidth would be usurped degrading the quality of the video with absolutely no benefits to the systems and methods taught by Mottur. The degradation in operation of the system of Mottur by the modification proposed by the Office is compelling evidence that there is no motivation to combine the reference teachings. MPEP 2143.01 V (8th ed., rev. 3) provides that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Claim 35 is allowable for at least these compelling reasons.

Referring to dependent claim 36, the method recites a communications channel and pipeline (configured to communicate video and a high resolution photograph) comprise different physical media configured to communicate electrical signals in parallel. The Office on page 17 of the Action relies upon Official Notice in support of the rejection. The undersigned hereby traverses and seasonably challenges any reliance upon Official Notice pursuant to MPEP §2144.03 (8th ed., rev. 3), and requests the Examiner cite a reference or affidavit in support of his or her position in a non-final Action if claim 36 is not allowed.

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MPEP 2144.03A (8th ed., rev. 3) provides that *official notice unsupported by documentary evidence should only be taken by the examiner when the facts asserted to be well known or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well known*. It is *not appropriate* for the Office to take office notice of facts without a reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.

The Examiner is reminded that the facts constituting the state of the art are normally subject to the possibility of rationale disagreement among reasonable men and are not amenable to the taking of judicial notice. See *In re Eynde*, 48OF.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973). The Examiner is also reminded that claims are analyzed in the context of the combination of the various separately stated limitations, and not with respect to the limitations individually. Pursuant to MPEP §2144.03 (8th ed., rev. 2), Applicant hereby demands evidence with respect to what the Examiner apparently relies upon as being "well-known."

MPEP 2144.03A gives examples of limitations which are considered well known, such as when new audio information is recorded then the old information is erased, or when a heat requirement is varied it is well known to vary a flame. The MPEP states that Official Notice is proper when the *teachings are readily verifiable* (e.g., use of a control in bacteriology). MPEP 2144.03B (8th ed., rev. 3). MPEP 2144.03A and 2144.04E make clear that *Official Notice is proper with respect to facts which are of notorious character and serve only to fill in the gaps in an insubstantial manner*. Appellants respectfully submit that entire positively recited limitations of claim 36 are not notorious and do not fill in gaps in an insubstantial manner but are rather directed toward entire limitations which are not found anywhere in the prior art.

There is no basis for the taking of Official Notice and the Office has failed to present specific factual findings predicated on sound technical and scientific reasoning with respect thereto but rather only submits general unsupported allegations regarding negative operations (e.g., cross talk) which has not been demonstrated to be of concern or issue in the teachings being modified. Applicants respectfully submit the Office has inappropriately disregarded the combination of limitations of the claims and improperly focused upon the limitations taken

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individually. The question under 35 U.S.C. §103 is not whether the differences between the prior art and the claims would have been obvious, but whether the claimed invention *as a whole* would have been obvious. *Stratoflex, Inc. vs. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871, 877 (Fed. Cir. 1983); M.P.E.P. §2141.02 (8th ed. Rev.3). Claim 35 is allowable for the above-mentioned compelling reasons.

Referring to dependent claim 44, the method recites limitations of previously pending claim 28 which was previously indicated by the Office to recite allowable subject matter. The Office now relies upon the method of Juen as allegedly teaching the limitations of claim 44. Applicants respectfully disagree and submit the Office has failed to present a prima facie 103 rejection of claim 44.

More specifically, there is no motivation to further modify the combination of Ramsubramanian and Mottur pursuant to the teachings of Juen. On page 18 of the Action, the Office baldly opines that the combination of Juen is appropriate "in order to allow a user to acquire a high resolution image of the video image which is better related to the video images." Applicants respectfully submit such motivation is insufficient to establish a proper prima facie 103 rejection.

As set forth in previous responses of Applicants, the CAFC and the MPEP provide that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. Further, deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense and the determination of patentability must be based on evidence. In the instant rejection, there is no evidence to support the alleged motivation and the Office has failed to establish a prima facie rejection for at least this reason.

More specifically, on page 18 in support of the rejection, the Office baldly without support alleges that the camera of Juen is advantageous because it clearly relates still images to video images. The Office has not pointed to any teachings or other evidence in support of the allegation that Juen provides still images which are better related to video images as baldly alleged. Furthermore, there is no evidence of record that the combination of Mottur and Ramsubramanian suffers from any issues of the relationship of the still and video images to motivate one to look to Juen for meaningful teachings regarding providing a better relationship thereof.

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There is no evidence of record that any improvement would result from the combination of the teachings of Juen with the teachings of Mottur and/or Ram. Contrary to the authority of the CAFC and MPEP, the Office has rejected the claims without evidence in support of the rejection. The Office has failed to establish a prima facie rejection for at least this reason and claim 44 is allowable.

Referring to claim 11, there is no motivation to combine the teachings of Ramsubramanian with the teachings of Mottur and the Office has failed to establish a proper 103 rejection for at least this reason.

The claims which depend from claim 11 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to dependent claim 46, even if the teachings of the references are combined, the combination fails to disclose or suggest positively-recited limitations of claim 46. More specifically, Ramsabramanian teaches the provision of photographs of frames of a previously generated video stored as a video file 104 as set forth in col. 3, lines 50+. The apparatus of claim 46 recites one or more photo-video acquisition devices capable of acquiring videos and high resolution photographs and wherein the devices individually comprise a remote video camera configured to acquire the videos and photographs of a live scene as originally viewed in real time for the first time by the respective remote video camera. The Office on page 4 of the Action alleges that Mottur teaches acquiring videos of a live scene as originally viewed in real time for the first time by the remote video cameras. However, the Office has pointed to no teachings in Mottur or Ramsabramanian of the claimed limitations of the remote video cameras configured to acquire the videos and photographs of a live scene. To the contrary, Applicants have only uncovered provision of photographs of frames of a previously generated video stored as a video file 104. The previously stored video file 104 of Ramsabramanian clearly fails to disclose or suggest the claimed camera configured to acquire the photographs of the live scene as originally viewed in real time for the first time. The prior art disclosing photographs of a video file is void of disclosing or suggesting the remote video camera in combination with the other limitations of claim 46 including acquiring high resolution photographs and claim 46 is allowable for at least this additional reason.

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Referring to independent claim 26, there is no motivation to combine the teachings of Ramsubramanian with the teachings of Mottur and the Office has failed to establish a proper 103 rejection for at least this reason.

Furthermore, positively recited limitations of the claims are not disclosed nor suggested by the prior art even if the references are combined and the Office has failed to establish a *prima facie* 103 rejection for this additional reason. Ramsubramanian discloses the capture of still images using a previously stored video file per col. 3, lines 55+. The teachings of the prior art even if combined are void of *generating a video of a scene viewed using a photo-video acquisition device comprising a camera* in combination with *acquiring a high resolution photograph using the video streamed from the photo-video acquisition device as a view finder* as positively recited in claim 26. Positively-recited limitations of claim 26 are not disclosed nor suggested by the prior art and the method of claim 26 is allowable for at least this reason.

Referring to claim 30, the Office has failed to recite sufficient motivation to combine the reference teachings and accordingly the Office has failed to provide a proper 103 rejection of claim 30. Applicants respectfully submit claim 30 is allowable for at least this reason.

In addition, even if the references are combined, there is no teaching or suggestion of *generating video using one or more photo-video acquisitions devices comprising cameras, or acquiring a high resolution photograph using the video streamed from the camera(s) as a view-finder as recited in claim 30*. Positively-recited limitations of claim 30 are not disclosed nor suggested by the prior art and the method of claim 30 is allowable for at least this reason.

The claims which depend from claim 30 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 34, the Office has failed to recite sufficient motivation to combine the reference teachings and accordingly the Office has failed to provide a proper 103 rejection of claim 34. Applicants respectfully submit claim 34 is allowable for at least this reason.

In addition, the combined teachings of the prior art fail to disclose or suggest *capturing live video data of a scene using a camera*, providing *still image data using*

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the captured live video data and the still image data having a resolution greater than a resolution of the live video data. Positively-recited limitations of claim 34 are not disclosed nor suggested by the prior art and the method of claim 34 is allowable for at least this reason.

The claims which depend from claim 34 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

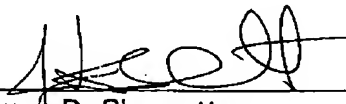
Applicant hereby adds new claims 44-49 which are supported at least by Figs. 1-4 and the associated respective teachings of the specification.

Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,
Pere Obrador et al.

By


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